

REMARKS

The Specification has been amended. Claims 1, 9, 11, 14 - 15, 17 - 18, 20 - 24, 28, 34, 37, and 90 have been amended. Claims 43 and 91 have been withdrawn from further consideration. Claims 96 - 98 have been added. No new matter has been introduced with these amended or added claims, all of which are supported in the specification as originally filed. Claims 2 - 8, 10, 12 - 13, 16, 19, 25 - 27, 29 - 33, 35 - 36, 38 - 42, 44 - 89, and 92 - 95 have been cancelled from the application without prejudice. Claims 1, 9, 11, 14 - 15, 17 - 18, 20 - 24, 28, 34, 37, 90, and 96 - 98 are now in the application.

I. Restriction Requirement

Paragraphs 1 - 4 on Pages 2 - 3 of the Office Action dated March 29, 2006 (hereinafter, "the Office Action") discuss a restriction requirement, and Paragraph 5 notes that a provisional election has been made without traverse to prosecute Claims 1 - 2, 5 - 12, 14 - 18, 20 - 24, 28, 34, 37, 67 - 68, 89 - 90, and 92 - 93, and that Claims 43, 46, 91, and 94 - 95 have been withdrawn by the Examiner from further consideration. Applicants hereby affirm the election of Claims 1 - 2, 5 - 12, 14 - 18, 20 - 24, 28, 34, 37, 67 - 68, 89 - 90, and 92 - 93 (and amendment and cancellation of various ones of these claims is noted herein).

II. Objection to the Specification

Paragraph 1 on Page 3 of the Office Action states that the disclosure is objected to because of a missing patent number. Appropriate amendments are provided herein, and the Examiner is respectfully requested to withdraw this objection.

III. Double-Patenting Rejection

Paragraph 3 on Page 4 of the Office Action states that Claims 1 - 2, 5 - 12, 14 - 18, 20 - 24, 28, 34, 37, 67 - 68, 89 - 90, and 92 - 93 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of Kovales, parent U. S. Patent 7,003,083 in view of U. S. Patent 6,459,774 B1 to Ball. Applicants respectfully submit that these claims are clearly distinguishable from parent U. S. Patent 7,003,083 and/or U. S. Patent 6,459,774 B1 to Ball, and these distinctions are clarified by the amendments made herein. The Examiner is therefore respectfully requested to withdraw the double-patenting rejection.

IV. Rejection Under 35 U. S. C. §102(e)

Paragraph 1 on Page 5 of the Office Action states that Claims 1 - 2, 5 - 9, 18, 22, 34, 67, 89, and 93 are rejected under 35 U.S.C. §102(e) as being anticipated by Ball. Claim 2, 5 - 8, 67, 89, and 93 have been cancelled from the application without prejudice, rendering the rejection moot as to those claims. This rejection is respectfully traversed with regard to Claims 1, 9, 18, 22, and 34 as presented herein.

Applicants' independent Claim 1 recites:

A method of enhancing a voice mail message for playback to a listener, further comprising steps of:

creating a voice mail message for a listener, by a caller using a telephone device, the voice mail message comprising a plurality of message segments;

identifying, by the caller using the telephone device, at least two of the message segments which are to have background sound associated therewith;

selecting, for each of the identified message segments by the caller using the telephone device, a sound to be associated therewith as the background sound, wherein the sounds selected as the background sound for at least two of the

message segments are different sounds; and

responsive to a request from the listener for playback of the voice mail message, playing back at least two of the identified message segments for which a sound was selected to be associated therewith as the background sound, while concurrently playing back the sound selected as the background sound for each of the played-back identified message segments, and wherein the sounds selected as the background sound for at least two of the played-back identified message segments are different sounds, such that the background sound played back for the voice mail message changes at least once during the playback. (emphasis added)

Applicants respectfully submit that Ball fails to teach (at least) the above-underlined limitations, as will now be described.

According to Ball, “... the structured message can be formulated by the sender through an editor with a graphical user interface running on a computer” (col. 3, lines 40 - 42) or “Alternatively, the structured message could be created ‘by hand’ with a text editor ...” (col. 3, lines 45 - 47). Applicants respectfully submit that this is distinct from “creating a voice mail message for a listener, by a caller using a telephone device” (Claim 1, line 3, emphasis added).

Applicants also respectfully submit that Ball does not teach or suggest “identifying, by the caller using the telephone device, at least two of the message segments which are to have background sound associated therewith” (Claim 1, lines 5 - 6, emphasis added). By contrast, Ball shows in **Table I** (col. 8, line 9) a syntax whereby a single line of the phone markup language (“PML”) file identifies a single background sound. The discussion of the background sound at col. 8, line 40 also pertains only to a single background of “inspirational music”, and col. 8, lines 40 - 52 indicate that the (single) background sound plays throughout the playback of the message.

Applicants further note that while reference number **1012** of **Fig. 10**, which is cited in the Office Action with regard to Claim 2, depicts a message having 3 audio files **1013, 1014, 1015** associated therewith, there is no suggestion, nor any teaching, in Ball that more than one of these files is a background sound. Rather, Ball explains that these reference numbers pertain to “audio fragments” which are “combined with selected textual fragments” (col. 28, lines 9 - 11). See, for example, col. 8, lines 7 - 52 (and in particular, lines 18 - 21), explaining how the 6 audio files identified in **Table I** for providing audio fragments are intermingled with text.

Applicants’ Claim 1 further states “wherein the sounds selected as the background sound for at least two of the message segments are different sounds” (Claim 1, lines 8 - 9, emphasis added), and the final element of Applicants’ Claim 1 specifies “such that the background sound played back for the voice mail message changes at least once during the playback” (Claim 1, lines 18 - 19, emphasis added). Because Ball does not teach or suggest use of more than one background sound for a particular message, it is clear that Ball does not teach or suggest these limitations of Applicants’ Claim 1. Accordingly, Ball fails to teach or suggest the above-underlined limitations from Claim 1, lines 5 - 6; line 8 - 9; and lines 18 - 19 of Applicants’ claim language.

Because Ball fails to teach all of the limitations of their independent Claim 1, Applicants respectfully submit that Claim 1 is not anticipated by Ball. Dependent Claims 9, 18, and 22 are therefore deemed patentable by virtue of (*inter alia*) the patentability of Claim 1, from which they depend.

Furthermore, Applicants have amended dependent Claim 9 to clarify that it pertains to a “caller-specific personal identification value”. (See, for example, page 14, lines 3 - 8 of Applicants’ specification, where this value is discussed.) Applicants respectfully submit that Ball has no teaching, nor any suggestion, of the limitations specified in Claim 9.

Applicants’ dependent Claim 22, as amended herein, specifies “... transmitting, for each of the selected sounds, an identifier thereof from the telephone device to an apparatus on which the voice mail message is being recorded, for use by the apparatus to obtain the played-back sounds” (Claim 22, emphasis added). Applicants respectfully submit that Ball does not teach these limitations: as discussed above with reference to Claim 1, line 3, Ball’s message creator is using “an editor with a graphical user interface running on a computer” (col. 3, lines 40 - 42) or “a text editor” (col. 3, lines 45 - 47), and this is distinct from an identifier “transmitt[ed] ... from the telephone device”, in contrast to Applicant’s Claim 22.

Applicants’ independent Claim 34 recites:

A method of enhancing voice mail messages for playback to a listener, further comprising steps of:

creating a voice mail message for a listener, by a caller using a telephone device, the voice mail message comprising a plurality of message segments;

selecting, by the caller using the telephone device, an audio file to insert into the voice mail message (1) between one or more selected pairs of successive ones of the message segments, (2) prior to a first one of the message segments, and/or (3) following a last one of the message segments, such that the selected audio file is associated with the selected pair(s) of message segments, the first one of the message segments, or the last one of the message segments, respectively; and

inserting the selected audio file between the successive ones of the message segments in its associated pair(s), prior to the associated first one of the message

segments, or following the associated last one of the message segments, as appropriate, as the voice mail message is played back to the listener. (emphasis added)

As discussed above with reference to Claim 1, Applicants respectfully submit that Ball does not teach that a voice mail message is created “by a caller using a telephone device”, and therefore does not teach (at least) the above-underlined limitations of independent Claim 34. Accordingly, Applicants respectfully submit that Ball fails to anticipate Claim 34.

In view of the above, the Examiner is respectfully requested to withdraw the §102 rejection.

V. Rejection Under 35 U. S. C. §103(a)

Paragraph 3 on Page 8 of the Office Action states that Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent 5,860,065 to Hsu. Paragraph 4 on Page 8 of the Office Action states that Claims 12, 16 - 17, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent 6,407,325 to Yi. Paragraph 5 on Page 10 of the Office Action states that Claims 11, 15, 28, and 92 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent 6,125,175 to Goldberg. Paragraph 6 on Page 11 of the Office Action states that Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent 6,634,992 to Ogawa. Paragraph 7 on Page 12 of the Office Action states that Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ball and Yi in view of Newton’s Dictionary. Paragraph 8 on

Page 12 of the Office Action states that Claims 23 - 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent Publication 2002/0082838 to Hinde.

Paragraph 9 on Page 13 of the Office Action states that Claims 37 and 68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent 6,532,477 to Tang.

Paragraph 10 on Page 14 of the Office Action states that Claim 90 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ball in view of U. S. Patent 5,850,431 to Satou. Claims 10, 12, 16, 68, and 92 have been cancelled from the application without prejudice. These rejections are respectfully traversed with regard to Claims 11, 14 - 15, 17, 20 - 21, 23 - 24, 28, 37, 90 as amended herein.

As noted above, Applicants respectfully submit that their independent Claim 1 is patentable over Ball. Accordingly, dependent Claims 11, 14 - 15, 17, 20 - 21, 23 - 24, 28, and 90 are therefore patentable by virtue of (*inter alia*) the independent Claim 1 from which they depend. In addition, Applicants have discussed, above, the patentability of independent Claim 34, and respectfully submit that Claim 37, which depends therefrom, is therefore patentable as well.

Applicants further note, with regard to dependent Claim 11, that the Office Action refers to col. 4, lines 48 - 49 of Goldberg. However, what is described therein are actions taken manually, by a first person (the “calling party”) while speaking to a second person. For example, the calling party may “press a specific number on the telephone keypad” or “say a specific word or words” (col. 4, lines 54 - 56), and in response to this type of action, the “processor dedicated to the call ... can then insert the background sound” (col. 4, lines 53 - 57). This is distinct from

“... causing the sounds ... to be automatically selected, based on the day on which the voice mail message is being created” (Claim 11, lines 5 - 7, emphasis added).

With regard to Claim 17, the Office Action cites Yi’s Abstract. Applicants respectfully submit that the cited discussion pertains to an MP3 player. Applicants have clarified their dependent Claim 17 herein to specify that “a plurality of sounds [from which the caller selects] are statically configured as sounds selectable from the telephone device” (emphasis added). This is distinct from an MP3 player.

In view of the above, Applicants respectfully request that the Examiner withdraw the §103 rejection.

VI. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding objections and rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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